IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicants: | Adams et al. | Examiner: | Sheikh, Asfand M. |
| Title: | TOOL, NETWORK AND METHOD FOR ASSET DATA UPDATING | Docket No.: | BLD920010001US1 (IBME-0019) |

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## APPEAL BRIEF

### Real Party in Interest

International Business Machines Corporation is the real party in interest.

### Related Appeals and Interferences

Applicants state that they are not currently aware of any prior or pending appeals,

interferences or judicial proceedings which may directly affect or be directly affected by or have

a bearing on the Board's decision in the pending appeal.

### Claim Status

As filed, this case included claims 1-22. Claims 1, 8, 13 and 22 are currently pending

and have been rejected as set forth in the Final Office Action dated January 28, 2008. The

claims on appeal are claims 1, 8, 13 and 22.

**Status of Amendments**

There have not been any amendments filed subsequent to the last issued Final Office Action.

**Summary of Claimed Subject Matter**

The claimed invention relates generally to a single hand-held portable tool and methods for locating an asset and updating asset data such as GPS location or asset type. The tool of the claimed invention further includes modules adapted to conduct tests on the asset, record information, scan a barcode on the asset, track user time, manage work orders, generate billing information and receive electronic signatures. The tool further includes asset tracking software that receives an asset GPS location, directs a service technician to the asset, calculates travel time and provides a real-time map based on a GPS location of the tool. Below is a concise explanation of the subjected matter defined in independent claims 1, 8, 13 and 22 which are each involved in this appeal. In addition, the summary points out elements in the figures that correspond to claim features as well as sections in the specification that discuss the features.

Claim 1 claims a tool for use by a service technician to find and service an asset that is geographically dispersed from other assets, the tool comprising: a single hand-held portable computing device (*see e.g.*, p. 6, ln. 15-16, p. 7, ln. 15-18, Fig. 1, item 10); a database located on the portable computing device; (*see e.g.*, p. 7, ln. 15-p. 8, ln. 1, Fig. 1, item 26) a wireless interface adapted for connecting the portable computing device to a network via a wireless access protocol; (*see e.g.*, p. 8, ln. 10-13, Fig. 1, item 30) software installed on the portable computing device, wherein the software includes at least one of a first module adapted to

conduct diagnostic tests on the asset, (*see e.g.*, p. 9, ln. 13-17, Fig. 2A, item 50) a second module

adapted to record information, (*see e.g.*, p. 9, ln. 13-17, Fig. 2A, item 50) and a third module

adapted to scan a barcode on the asset, (*see e.g.*, p. 10, ln. 15-19, Fig. 2A, item 62) wherein the

software includes a fourth module adapted to track user time, (*see e.g.*, p. 10, ln. 4-9, Fig. 2A,

item 56) a fifth module adapted to manage work orders, (*see e.g.*, p. 10, ln. 1-4, Fig. 2A, item 54)

and a sixth module adapted to generate billing information, (*see e.g.*, p. 10, ln. 10-12, Fig. 2A,

item 58) wherein the software includes a seventh module adapted to receive electronic signatures

on the portable computing device (*see e.g.*, p. 10, ln. 13-14, Fig. 2A, item 60), and wherein the

software includes messaging software; (*see e.g.*, p. 10, ln. 20 – p. 11, ln. 2, Fig. 2A, item 64) a

global positioning system (GPS) device attached to the portable computing device; (*see e.g.*, p. 8,

ln. 15-16, Fig. 1, item 34) and asset tracking software, installed on the portable computing

device, (*see e.g.*, p. 11, ln. 12 – p. 12, ln. 7, Fig. 1, item 42) for receiving an asset GPS location

from the asset via the wireless interface, (*see e.g.*, p. 11, ln. 12-19, Fig. 1, item 42) for directing

the service technician to the asset, (*see e.g.*, p. 11, ln. 19 – p. 12, ln. 2, Fig. 1, item 42) and for

updating asset data, including the asset GPS location, via the wireless interface, (*see e.g.*, p. 12,

ln. 6-7, p. 16, ln. 8-20, Fig. 1, item 48) wherein the asset tracking software includes an eighth

module adapted to calculate travel time from a first location to a second location, (*see e.g.*, p. 11,

ln. 2-5, Fig. 1, item 47) and wherein the asset tracking software includes a ninth module adapted

to provide a real-time map based on a GPS location of the tool. (*see e.g.*, p. 15, ln. 10-14, p. 17,

ln. 6-8, Fig. 1, item 46).

Claim 8 claims a network for managing a single hand-held portable computing device

used by a user locating and servicing an asset that is geographically dispersed from other assets,

the network comprising: a wireless interface adapted for communicating with the portable

computing device via a wireless access protocol; (*see e.g.,* p. 8, ln. 10-13, Fig. 1, item 30),

software for providing asset data (*see e.g.,* p. 11, ln. 12 – p. 12, ln. 7, Fig. 1, item 42) including

an asset GPS location from the asset via the wireless interface to the portable computing device,

(*see e.g.,* p. 11, ln. 12-19, Fig. 1, item 42) for directing the user to the asset, (*see e.g.,* p. 11, ln. 19

– p. 12, ln. 2, Fig. 1, item 42) and for receiving an update of asset data, including the asset GPS

location, from the portable computing device via the wireless interface; (*see e.g.,* p. 12, ln. 6-7, p.

16, ln. 8-20, Fig. 1, item 48); software including a first module adapted to track user time, (*see*

*e.g.,* p. 10, ln. 4-9, Fig. 2A, item 56); a second module adapted to manage work orders (*see e.g.,*

p. 10, ln. 1-4, Fig. 2A, item 54) and a third module adapted to generate billing information, (*see*

*e.g.,* p. 10, ln. 10-12, Fig. 2A, item 58) wherein the software further includes a fourth module

adapted to receive electronic signatures from the portable computing device; (*see e.g.,* p. 10, ln.

13-14, Fig. 2A, item 60) and  at least one database. (*see e.g.,* p. 7, ln. 15-p. 8, ln. 1, Fig. 1, item

26).

Claim 12 claims a tool for use by a service technician to find and service an asset that is

geographically dispersed from other assets, the tool comprising: a single hand-held portable

computing device; (*see e.g.,* p. 6, ln. 15-16, p. 7, ln. 15-18, Fig. 1, item 10), a database located on

the portable computing device; (*see e.g.,* p. 7, ln. 15-p. 8, ln. 1, Fig. 1, item 26), means for

connecting the portable computing device to a network; (*see e.g.,* p. 8, ln. 8-14, Fig. 1, item 24);

means for accessing the database; (*see e.g.,* p. 8, ln. 3-14), means, attached to the portable

computing device, for determining a global position of the portable computing device; (*see e.g.,*

p. 8, ln. 15-16, Fig. 1, item 34) and means for providing an asset GPS location from the asset that

is received via the means for connecting, (*see e.g.,* p. 11, ln. 12-19, Fig. 1, item 42), for directing

the service technician to the asset, (*see e.g.,* p. 11, ln. 19 – p. 12, ln. 2, Fig. 1, item 42) and for

updating asset data, including the asset GPS location, via the means for connecting. (*see e.g.*, p. 12, ln. 6-7, p. 16, ln. 8-20, Fig. 1, item 48).

Claim 13 claims a tool for use by a service technician to find and service an asset that is geographically dispersed from other assets, the tool comprising: a single hand-held portable computing device; (*see e.g.*, p. 6, ln. 15-16, p. 7, ln. 15-18, Fig. 1, item 10); a database located on the portable computing device; (*see e.g.*, p. 7, ln. 15-p. 8, ln. 1, Fig. 1, item 26), a wireless interface adapted for connecting the portable computing device to a network via a wireless access protocol; (*see e.g.,* p. 8, ln. 10-13, Fig. 1, item 30); first software installed on the portable computing device for accessing the database; (*see e.g.*, p. 8, ln. 3-14); a global positioning system (GPS) device attached to the portable computing device; (*see e.g.*, p. 8, ln. 15-16, Fig. 1, item 34) and second software, installed on the portable computing device, for receiving an asset GPS location from the asset via the wireless interface, (*see e.g.*, p. 11, ln. 12-19, Fig. 1, item 42) for directing the service technician to the asset, (*see e.g.*, p. 11, ln. 19 – p. 12, ln. 2, Fig. 1, item 42) and for updating asset data, including the GPS location, via the wireless interface, (*see e.g.*, p. 12, ln. 6-7, p. 16, ln. 8-20, Fig. 1, item 48); wherein the first software includes a first module adapted to track user time, (*see e.g.*, p. 10, ln. 4-9, Fig. 2A, item 56) a second management module adapted to manage work orders (*see e.g.*, p. 10, ln. 1-4, Fig. 2A, item 54) and a third module adapted to generate billing information. (*see e.g.*, p. 10, ln. 10-12, Fig. 2A, item 58).

Claim 22 claims a tool for use by a service technician to find and service an asset that is geographically dispersed from other assets, the tool comprising: a single hand-held portable computing device; (*see e.g.*, p. 6, ln. 15-16, p. 7, ln. 15-18, Fig. 1, item 10); a database located on the portable computing device; (*see e.g.*, p. 7, ln. 15-p. 8, ln. 1, Fig. 1, item 26); means for connecting the portable computing device to a network; (*see e.g.*, p. 8, ln. 8-14, Fig. 1, item 24);

software including: means for tracking time of a user on the tool; (*see e.g.*, p. 11, ln. 2-5, Fig. 1, item 47) means for managing work orders on the tool; (*see e.g.*, p. 10, ln. 1-4, Fig. 2A, item 54) and means for generating billing information on the tool; (*see e.g.*, p. 10, ln. 10-12, Fig. 2A, item 58); means, attached to the portable computing device, for determining a global position of the portable computing device; (*see e.g.*, p. 8, ln. 15-16, Fig. 1, item 34) and means for providing an asset GPS location that is received from the asset via the means for connecting, (*see e.g.*, p. 11, ln. 12-19) for directing the service technician to the asset, (*see e.g.*, p. 11, ln. 19 – p. 12, ln. 2, Fig. 1, item 42) and for updating asset data, including the asset GPS location, via the means for connecting. (*see e.g.*, p. 12, ln. 6-7, p. 16, ln. 8-20, Fig. 1, item 48).

**Grounds of Rejection to be Reviewed on Appeal**

1.      Whether claims 1, 8, 13 and 22 are patentable under 35 U.S.C. 103(a) over Barbosa (U.S. Pat. No. 6,961,586), in view of Horton *et al.* (U.S. Pat. No. 5,533,093), Edgar (U.S. Pat. No. 5,930,770), Morrow *et al,* (U.S. Pat. Pub. No. 2002/0156668), Bridgelall, (U.S. Pat. No. 7,005,968) and Park *et al.* (U.S. Pat. No. 6,334,086).

**ARGUMENT**

Appellants respectfully submit that the rejection of claims 1, 8, 12, 13 and 22 under 35 U.S.C. 103(a) over the six cited references is defective. The Examiner has the burden to establish a *prima facie* case of obviousness. Section 103 of Title 35 of the United States Code provides the test for obviousness under which the pending claims have been rejected:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The Examiner has the burden of establishing a *prima facie* case for obviousness when rejecting an application under Section 103. *Ex parte Clapp,* 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka,* 180 USPQ 580, 583 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson,* 165 USPQ 494, 496 (CCPA 1970). If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *See In re Fine,* 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Appellants respectfully submit that the six cited reference fails to meet each of the three basic criteria required to establish a prima facie case of obviousness. As such, the rejection under 35 U.S.C. §103(a) is defective.

With regard to the Office's rejections under 35 U.S.C. §103(a), Applicants assert that the references cited by the Office do not teach or suggest each and every feature of the claimed invention. For example, Applicants respectfully submit that the cited references fail to teach or

suggest a single, hand-held device having all of the functionality embodied with claims 1, 8, 12, 13 and 22, respectively. The Office uses six references in an attempt to deal with the majority of the features of the claimed invention. Applicants contend that the use of this many references makes the rejection untenable by, inter alia, destroying the Office's motivation to modify. For example, the Office attempts to argue that it would be obvious to alter the Barbosa reference by adding in at least five different elements allegedly disclosed in five different references. Such an alteration of Barbosa would render the invention unworkable, and would certainly not have a reasonable expectation of success. For example, the Office cites to Park for disclosure of a module adapted to calculate travel time between locations. However, Park's system is an apparatus and method for collecting traffic information, and is not workable as a handheld device. As such, its combination with Barbosa and the other cited references is not feasible nor proper.

The claimed invention claims a single handheld device that incorporates software (including several modules providing varied functions), a GPS device, and an asset tracking software that also performs several different functions. Because the Office was unable to find prior art that disclosed all of these features, the Office has improperly attempted to cobble together six different references, spanning different art areas, to show that the claimed invention would be obvious. However, the Office's attempt is improper because even if, *arguendo*, the cited references disclose general concepts that are present in the claimed invention (*e.g.*, the instant messaging of Morrow, or the mapping software of Barbosa), none of the six references incorporate the claimed limitations in the same way, to perform the same function, as the claimed invention.

Still further, Applicants submit that even with the use of the six references, the Office still has not shown that the claimed invention teaches each and every feature of the claimed invention, including, but not limited to: a single handheld tool for use by a service technician to find and service an asset that is geographically dispersed from other assets and asset tracking software, installed on the portable computing device, for receiving an asset GPS location from the asset via the wireless interface, for directing the service technician to the asset, and for updating asset data, including the asset GPS location, via the wireless interface. The Office cites to Bridgelall for the disclosure of these limitations, however, interpreting Bridgelall for purposes of this Appeal only, Bridgelall discloses a simple RFID tracking system that tracks assets with marker and locator tags. This RFID tracking system is not equivalent to the claimed asset tracking software. Bridgelall system does not place tracking software on a handheld device that would direct a service technician to an asset, update asset data, etc. The Office cites a disclosure in Bridgelall that a customer could use a "self-shopper" which the Office equates with the handheld device of the claimed invention. However, even if, *arguendo*, a "self-shopper" is a handheld portable device, Bridgelall does not disclose installing asset tracker software on the "self-shopper." In contrast, the "self-shopper" of Bridgelall simply includes an RFID tag that can be used to send the shopper information. As such, Bridgelall does not disclose the asset tracking software installed on a single handheld device as claimed in the claimed invention.

**Conclusion**

In summary, Appellants submit that claims 1, 8, 12, 13 and 22 are allowable because the Examiner has not shown that all the claim limitations are taught or suggested by the prior art. In particular, the Examiner has failed to support the burden of establishing a prima facie case of

obviousness over the six cited reference. Therefore, Appellant submits that the obviousness

rejections are untenable and requests that the Board reverse the rejections set forth in the Office

Action.

Respectfully submitted,

Date: May 28, 2008

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# CLAIMS APPENDIX

The following is a listing of the current claims involved in the appeal:

1.A tool for use by a service technician to find and service an asset that is geographically dispersed from other assets, the tool comprising:

a single hand-held portable computing device;

a database located on the portable computing device;

a wireless interface adapted for connecting the portable computing device to a network via a wireless access protocol;

software installed on the portable computing device, wherein the software includes at least one of a first module adapted to conduct diagnostic tests on the asset, a second module adapted to record information, and a third module adapted to scan a barcode on the asset, wherein the software includes a fourth module adapted to track user time, a fifth module adapted to manage work orders, and a sixth module adapted to generate billing information, wherein the software includes a seventh module adapted to receive electronic signatures on the portable computing device, and wherein the software includes messaging software;

a global positioning system (GPS) device attached to the portable computing device; and

asset tracking software, installed on the portable computing device, for receiving an asset GPS location from the asset via the wireless interface, for directing the service technician to the asset, and for updating asset data, including the asset GPS location, via the wireless interface, wherein the asset tracking software includes an eighth module adapted to calculate travel time

from a first location to a second location, and wherein the asset tracking software includes a ninth module adapted to provide a real-time map based on a GPS location of the tool.

8.      A network for managing a single hand-held portable computing device used by a user locating and servicing an asset that is geographically dispersed from other assets, the network comprising:

a wireless interface adapted for communicating with the portable computing device via a wireless access protocol;

software for providing asset data including an asset GPS location from the asset via the wireless interface to the portable computing device, for directing the user to the asset, and for receiving an update of asset data, including the asset GPS location, from the portable computing device via the wireless interface;

software including a first module adapted to track user time, a second module adapted to manage work orders and a third module adapted to generate billing information, wherein the software further includes a fourth module adapted to receive electronic signatures from the portable computing device; and

at least one database.

12.     A tool for use by a service technician to find and service an asset that is geographically dispersed from other assets, the tool comprising:

a single hand-held portable computing device;

a database located on the portable computing device;

means for connecting the portable computing device to a network;

means for accessing the database;

means, attached to the portable computing device, for determining a global position of the portable computing device; and

means for providing an asset GPS location from the asset that is received via the means for connecting, for directing the service technician to the asset, and for updating asset data, including the asset GPS location, via the means for connecting.

13.	A tool for use by a service technician to find and service an asset that is geographically dispersed from other assets, the tool comprising:

a single hand-held portable computing device;

a database located on the portable computing device;

a wireless interface adapted for connecting the portable computing device to a network via a wireless access protocol;

first software installed on the portable computing device for accessing the database;

a global positioning system (GPS) device attached to the portable computing device; and

second software, installed on the portable computing device, for receiving an asset GPS location from the asset via the wireless interface, for directing the service technician to the asset, and for updating asset data, including the GPS location, via the wireless interface,

wherein the first software includes a first module adapted to track user time, a second management module adapted to manage work orders and a third module adapted to generate billing information.

22. A tool for use by a service technician to find and service an asset that is geographically

dispersed from other assets, the tool comprising:

a single hand-held portable computing device;

a database located on the portable computing device;

means for connecting the portable computing device to a network;

software including:

means for tracking time of a user on the tool;

means for managing work orders on the tool; and

means for generating billing information on the tool;

means, attached to the portable computing device, for determining a global

position of the portable computing device; and

means for providing an asset GPS location that is received from the asset via the

means for connecting, for directing the service technician to the asset, and for updating

asset data, including the asset GPS location, via the means for connecting.

## EVIDENCE APPENDIX

No evidence is entered and relied upon in the appeal.

# RELATED PROCEEDINGS APPENDIX

No decisions rendered by a court or the Board in any proceeding are identified in the related appeals and interferences section.